

## **Remarks**

### **Status of the Claims**

This paper is filed in response to the Office Action mailed October 10, 2008, in which claims 1-37 were pending in the application. All pending claims stand rejected. By this paper, claims 1, 2, and 3 have been amended. For the reasons set forth below, Applicants submit that each of the pending claims is patentably distinct from the cited prior art and in condition for immediate allowance. Reconsideration of the claims is therefore respectfully requested.

### **Claim Rejections**

Claims 1-27 stand rejected under 35 U.S.C. § 101. Claims 1-37 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,952,213 issued by Bowman et al. (“Bowman”). For the reasons set forth below, Applicants respectfully traverse both the claim rejections under 35 U.S.C. § 101 and those under 35 U.S.C. § 102(b).

### **Claim Rejections Under 35 U.S.C. § 101**

The Office Action asserts that claim 1 “positively recites a part of a human” at lines 14-15 of the claim. Page 2. Applicants respectfully disagree and direct the Examiner’s attention to line 13 of claim 1, which puts lines 14-15 in context. Lines 13-15 of claim 1 recite:

wherein the device ***is configured to be*** selectively adjusted in both a rotational and translational manner while at least a portion of the device is anchored to the bone

Claim 1, lines 13-15 (emphasis added).

As the highlighted text illustrates, the claim recites that the device “is configured to be selectively adjusted . . . while at least a portion of the device is anchored to the bone.” By including the “configured to” language, Applicants have not positively recited the bone. Rather, the claim recites functional language and only recites the bone as the environment within which the claimed function is to be performed.

The Office Action further asserts that claim 1 recites “a device’ which isn’t necessarily part of the ‘first member’ configured to be attached to bone in line 3 of claim 1.” Page 2. The Office Action then recommends that the claim be amended to recite that a portion of the devices is “configured to be anchored to the bone.” *Id.* In response, Applicants note that “the device” referenced on line 13 of claim 1 is the “orthopedic cutting guide device” set forth in the preamble of the claim. As such, it is necessarily the case that “first member”—which is recited as being “configured to be anchored to the bone”—is part of the claimed “device.” Although Applicants believe that this relationship was already clear from the language of claim 1, in order to avoid further delay to issuance of the Application, claim 1 has been amended to replace “the device” on line 13 with “the orthopedic cutting guide device” in order to further clarify the intended scope of the claim.

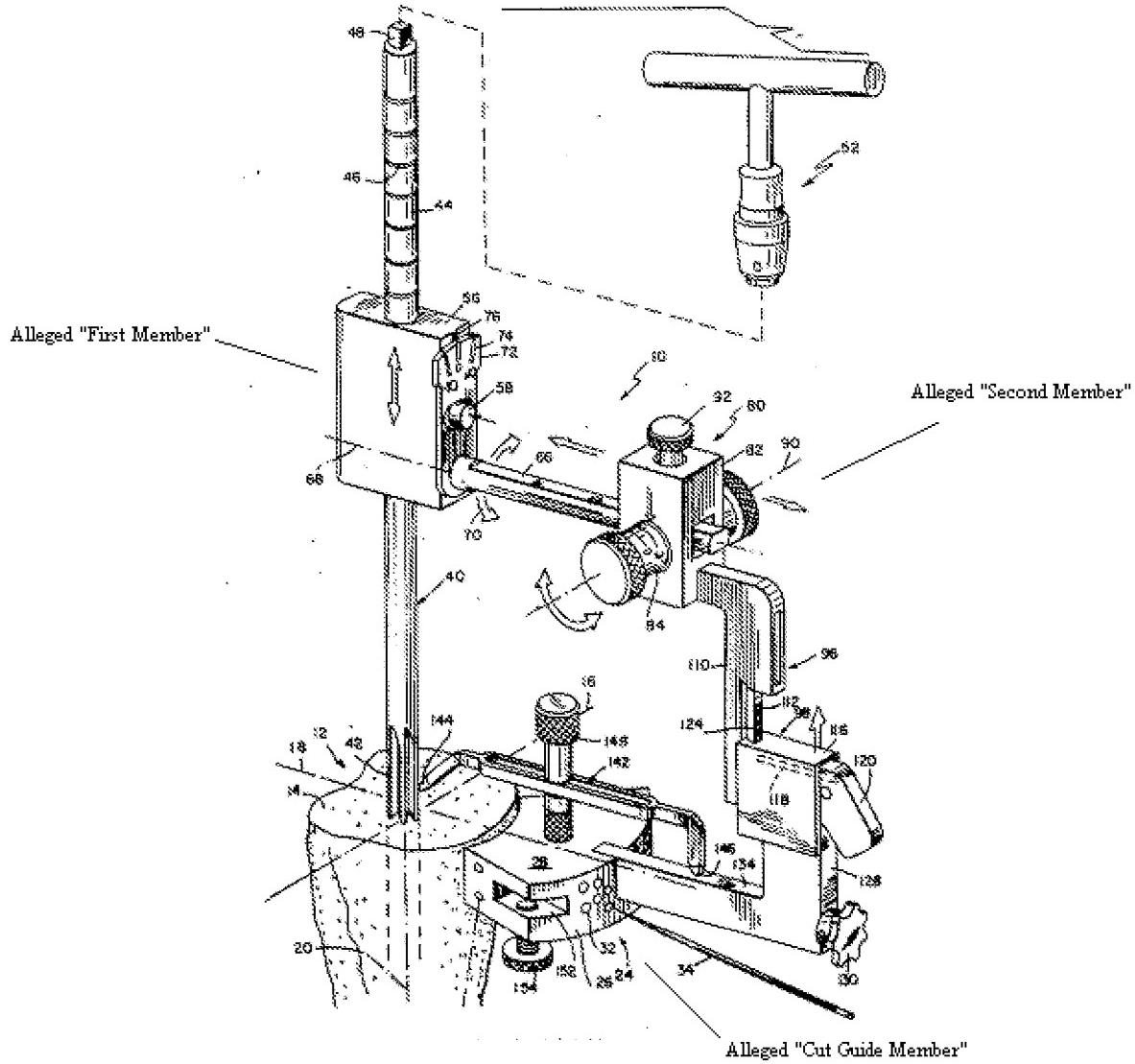
To provide further clarification, Applicants have also amended claim 1 to recite that the device is configured to be selectively adjusted . . . “while at least a portion of the ***first member***,” rather than ***the device***, “is anchored to the bone.” To the extent there was an ambiguity in the previous claims, it is submitted that these claim amendments make the recited functionality of the device in claim 1 overwhelmingly clear.

Applicants have also amended claim 2 as suggested by the Examiner. Finally, Applicants have amended claim 3 to provide additional clarification. For the foregoing reasons, it is respectfully requested that the claim rejections under 35 U.S.C. § 101 be withdrawn.

Claim Rejections Under 35 U.S.C. § 102(b)

Bowman has been cited in support of all claim rejections under 35 U.S.C. § 102(b). However, these rejections are respectfully traversed. As discussed below, Bowman fails to anticipate independent claim 1, from which all other pending claims depend.

Figure 1 of Bowman is reproduced below for the Examiner’s convenience. The Examiner has asserted that the claimed “first member” is satisfied by the “entire section on left which has a pivot axis extending along the length [from element 48 to element 42].” Office Action at page 3. The claimed “second member” is allegedly satisfied by the “L-shaped section extending to the right and down,” presumably made up of support bar 66, pivot device 80, and support arm assembly 96. *Id.* The claimed “cut guide member” is allegedly satisfied by saw guide assembly 24. *Id.*



1), the alleged first member is ***not*** positioned in between the alleged cut guide member and the alleged second member. To the contrary, the alleged first member is connected with and positioned directly adjacent to the alleged second member, which is connected with and positioned directly adjacent to the alleged cut guide member. If anything, the alleged ***second*** member is positioned in between the cut guide member and the alleged ***first*** member.

Moreover, claim 1 also recites that “the cut guide member and the second member ***move together about the pivot of the first member when said second member is selectively released from said first member.***” Neither the alleged cut guide member nor the alleged second member move about the alleged pivot at all, let alone ***both*** members moving together about the alleged pivot as demanded by the claim language. In fact, there is no movement about the pivot axis identified by the Examiner at all.

To further illustrate the above points, claim 1 requires that the member configured to be anchored to the bone (the “first member”) be positioned in between two other elements (the “second member” and the “cut guide member”) such that the two other elements move together about the pivot of the intermediary anchored member. This is simply not the case with the Bowman device. Bowman therefore fails to anticipate independent claim 1. For at least the same reasons, Bowman also fails to anticipate each of the pending dependent claims.

### Dependent Claims

In addition to the reasons set forth above in connection with independent claim 1, several dependent claims contain independently patentable subject matter not anticipated by Bowman, some of which are not referenced in the Office Action.

For example, with respect to dependent claim 8, the alleged “first member” in Bowman does not have an “outer wall tapering outwardly from a central reference point toward the first end and the second end,” as required by the claim language. The Examiner implies that portion 42 might be considered a tapering portion, but even assuming it does, there is no tapering towards the other end of the first member. Claim 8 demands that the outer wall taper from a central reference point toward the first end **and** the second end.

The alleged first member also does not have two substantially rounded ends, let alone substantially rounded ends that each act as a pivot, as required by dependent claim 9. It appears that the Examiner has made no attempt to assert that Bowman satisfies these limitations.

Similarly, several other dependent claims contain subject matter not taught or suggested by Bowman, and not addressed in the Office Action. For example, at least dependent claims 12, 16, 17, 18, 19, 20, 23, 28, 34 set forth limitations that are clearly not found in Bowman, and it appears these limitations are also not addressed in the Office Action. Applicants respectfully submit that these claims are independently patentable. To the extent that the Application is not considered immediately allowable, it is respectfully requested that the Examiner address the subject matter in each of the dependent claims separately.

Conclusion

For at least the foregoing reasons, all claims are patentably distinct from the cited prior art. A Notice of Allowance is respectfully requested. Should any further issues remain that would preclude the prompt issuance of a Notice of Allowance, the Examiner is requested to contact the undersigned.

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Respectfully submitted,

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